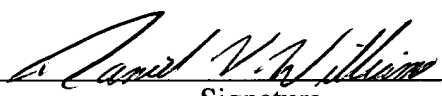


<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number <b>Q59406</b>	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number <b>09/648,532</b>		Filed <b>August 28, 2000</b>
	First Named Inventor <b>Dan EMODI</b>		
	Art Unit <b>3661</b>		Examiner <b>Cuong H. NGUYEN</b>
<p style="text-align: center;">WASHINGTON OFFICE <b>23373</b> CUSTOMER NUMBER</p>			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record.</p> <p>Registration number <u>45,221</u></p> <div style="text-align: right;">         Signature     </div> <div style="text-align: right;"> <u>Daniel V. Williams</u>        Typed or printed name     </div> <div style="text-align: right;"> <u>(202) 293-7060</u>        Telephone number     </div> <div style="text-align: right;"> <u>November 30, 2005</u>        Date     </div>			



**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q59406

Dan EMODI, et al.

Appln. No.: 09/648,532

Group Art Unit: 3661

Confirmation No.: 7780

Examiner: Cuong H. NGUYEN

Filed: August 28, 2000

For: **SYSTEM AND METHOD ENABLING REMOTE ACCESS  
TO AND CUSTOMIZATION OF MULTIMEDIA**

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**MAIL STOP AF - Patents**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, described in a Notice in the 12 July 2005 Official Gazette, and further to the final Office Action dated May 31, 2005, Applicants request a pre-appeal brief conference review of the final rejections in the above-identified application. This Request is accompanied by the filing of a Notice of Appeal.

Applicants turn now to the rejections at issue. Claims 1 and 59-61 are rejected under 35 U.S.C. § 102(b) as being anticipated by Bro (U.S. Patent 5,722,418). Claims 2,3, 25-28, 57 and 58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bro in view of Foladare et al. (U.S. Patent 6,343,115 [hereinafter "Foladare"]). Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bro in view of Foladare and further in view of Barbara et al. (U.S. Patent 5,926,789). Claims 5-7, 9-10, and 12-13 are rejected under 35 U.S.C. § 103 as being unpatentable over Bro, in view of Ellis, Foladare, Barbara and further in view of Aktas et al. (U.S. Patent 6,459,776). Claim 14 is rejected under 35 U.S.C. § 103 as being unpatentable over Bro, Foladare and Barbara. Claims 8, 11, 15-20 are rejected under 35 U.S.C. § 103 as being

unpatentable over Bro, Foladare, Barbara, Ellis and Kelkar et al. (U.S. Patent 6,182,128). Claims 21-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bro, Ellis, Foladare and Stokes (U.S. Patent 4,870,515).

With respect to the rejection of claims 1 and 59-61 under 37 C.F.R. § 103(a) in view of Bro, Applicants submit that Bro fails to teach or suggest each feature defined by these claims. Therefore, a *prima facie* obviousness has not been established. Claims 1, 59 and 60 are the only pending independent claims.

Claim 1 defines an apparatus for storing predetermined multimedia information comprising, *inter alia*, “a first telephony platform for receiving a command from a user’s access device and for generating a menu containing criteria options relating to at least one of a music track and a video track so that the user can make a selection...”

Claim 59 defines an apparatus for storing predetermined multimedia information comprising, *inter alia*, “first telephony platform means for receiving a command from a user’s wireless access device for generating a menu containing criteria options relating to at least one of a music track and a video track so that the user can select an option pertaining to said at least one of a music track and a video track...”

Claims 60 defines an apparatus for storing predetermined multimedia information comprising, *inter alia*, “a first telephony platform for receiving a purchasing command from a user initiated telephone call and for generating a menu containing musical criteria options relating to music tracks so that a user can listen to at least a portion of a selected music track through the telephone and purchase music information corresponding to the selected music track...”

The Examiner alleges that Bro discloses a “telephony platform” and a “storage location coupled to said telephony platform.” *See*, Office Action dated, page 3, paragraphs 2 and 3.

As a preliminary matter, the Examiner has only addressed the claimed “telephony platform” and “storage location coupled to said telephony platform.” *Id.* A *prima facie* case of obvious requires that the applied art teach or suggest each of the claimed features. In this case, Bro does not teach or suggest at least a first telephony platform “for receiving a command from a

user's access device and for generating a menu containing criteria options relating to at least one of a music track and a video track so that the user can make a selection.” Likewise, Bro does not teach or suggest the recitations of claims 59 and 60, nor has the Examiner addressed the details of these features. Because the Examiner has not addressed each feature of claims 1, 59 and 60, and because Bro does not teach or suggest these features, a *prima facie* case of obvious has not been established.

Bro discloses a method of mediating behavioral through interactive telecommunications systems, such that a physician or counselor may provide a series of motivational messages for a client to hear. Applicants previously asserted that an audio voice message alone does not teach a music or video track. *See*, Amendment dated March 18, 2005, page 13, last paragraph. The Examiner attempts to address Applicants' position by asserting that “merely recording a sound track”(sic.) *See*, Final Office Action dated May 31, 2005, section 3, last line. However, it is respectfully submitted that the Examiner's position is not clear. Regardless, the voice recording in Bro does not teach or suggest a first telephony platform for receiving a command from a user's access device and for generating a menu containing criteria options relating to at least one of a music track and a video track so that the user can make a selection, as recited in claim 1, nor does Bro teach or suggest the similar recitations of claims 59 and 60. For example, one would not be taught criteria options relating to at least one of a music track and a video track, based on the mere disclosure of a voice recording. Therefore, for at least this reason, Applicants submit that the features of claims 1, 59 and 60 are not taught or suggested by Bro. The remaining rejections rely on Bro and should similarly be withdrawn for at least this reason.

In regard to claim 3, the Examiner asserts that Bro “discloses that multimedia information comprises voice/music information.” *See*, Office Action dated May 31, 2005, page 7, lines 11-12. However, the section of Bro cited by the Examiner (i.e., col. 54, lines 8-34) does not teach or suggest the claimed first telephony platform for receiving a command from a user's access device and for generating a menu containing criteria options relating to at least one of a music track and a video track so that the user can make a selection. Instead, Bro discloses that music

may be included to “provide visual imagery with greater emotional impact.” *See*, Bro, col. 54, lines 28-30. Applicants submit that the use of such background music in Bro does not teach or suggest the claimed “menu containing criteria options relating to at least one of a music track and a video track so that the user can make a selection.” The Examiner even acknowledges that neither Bro nor Foladare teach the claimed features regarding “music tracks.” *See*, Office Action dated May 31, 2005, page 7, lines 17-18. Therefore, neither Bro nor Foladare teach or suggest the features of claim 3.

A further fundamental deficiency of the May 31, 2005 Office Action is the absence of weight give to various claimed features, which the Examiner acknowledges are not taught or suggested by the art. Applicants submit that “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *See*, MPEP 2143.03. It is therefore improper for the Examiner to acknowledge that the claimed features are not provided by the art and then merely dismiss such features, as was done multiple times in the May 31, 2005 Office Action, e.g., page 6, line 19- page 7, line 4; page 9, lines 6-11; page 10, lines 1-3 and lines 11-16; page 11, lines 2-6; page 12, lines 18-23; page 13, lines 1-6; page 13, lines 12-17. A *prima facie* case of obvious has not been established for at least this additional reason.

Even further, the Examiner attempts to ignore additional claimed features by asserting that the art is “capable” of providing the features. Without conceding as to whether or not the art is capable of being modified to include the claimed features, it is well established that although a prior art device “may be capable of being modified ... the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” (Emphasis added.) *See*, MPEP §2143.01. For example, the grounds of rejection contend that “Bro’s apparatus is capable of selecting a particular environment for a user, i.e., recording a selected music track.” *See*, Office Acton dated May 31, 2005, page 4, lines 8-9.<sup>1</sup> Nevertheless, there is no motivation to modify

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<sup>1</sup> Applicants note that claim 1 does not explicitly recite “selecting a particular environment for a user or recording a selected music track.”

Bro to include the features of claim 1 regarding a menu containing criteria options relating to at least one of a music track and a video track so that the user can make a selection. Accordingly, for this additional reason, a *prime facie* case of obviousness has not been established. Applicants also draw attention to the following additional sections of the May 31, 2005 Office Action that improperly attempt to supplement the references' deficient teachings by asserting that the art is "capable" of providing the claimed features: see page 6, lines 10-12; and page 15, lines 5-7.

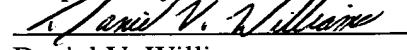
Moreover, Applicants respectfully submit that motivation to combine or modify the references' must be established to support a *prime facie* case of obvious. In the present case, the asserted motivations are attenuated and improper. For example, the Examiner's proposed motivation to modify Bro, in regard to claims 1 and 59-61, is to provide "an apparatus that can do a specific selection." (See Office Action dated May 31, 2005, page 4, line 9). Applicants respectfully submit that such a conclusion is not a proper motivation. It is also respectfully submitted that the Office Action dated May 31, 2005 includes additional, equally non-applicable motivational conclusions on page 5, lines 17-22; page 7, lines 5-7; page 7, line 21-page 8, line 4; page 10, lines 16-20; page 14, lines 18-21; and page 15, lines 1-4.

Accordingly, Applicants respectfully submit that a *prime facie* case of obvious has not been established at least because of the references' failure to teach or suggest each of the claimed features, and the lack of motivation to combine the references' teachings.

For at least the foregoing reasons, the rejections of pending claims 1-28 and 57-61 are improper.

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CUSTOMER NUMBER  
Date: November 30, 2005

Respectfully submitted,

  
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